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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/689,379

10/20/2003

Craig D. Yardley

2734.377-02

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10/16/2006

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EXAMINER

HARMON, CHRISTOPHER R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,379

Applicant(s)

YARDLEY ET AL.

Examiner

Christopher R. Harmon

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3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/14/06 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 80-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "of at least about" (claim 80, line 4; claim 82, line 3; claim 84, line 4; claim 87, line 3) is indefinite. The scope of "about" is not clear. In paragraph 071, page 23 of the specification the ranges for the length are "about 9.5 – about 13.5 inches" and width "about 3 to about 7 inches". A specific determination of what applicant intends to cover by "at least about 2 to 1" cannot be made. Furthermore "the machine direction" and "the cross-machine direction" lack antecedent basis; see claims 80 and 84.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 80-81, 84, 86, and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazar (US 1,256,334).

Lazar discloses a method of making a paper napkin comprising providing a single ply paper web with a longitudinal to transverse aspect ratio of about 2 to 1; folding one free edge towards the other edge to create two panels 3 and 4; folding the transverse fold 2 towards the free edge for a four paneled web; see figures 4 and 6. The panels have approximately equal areas.

6. Claims 84-85 and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan (US 5,716,691).

Chan discloses a method of folding a web by folding a transverse free edge toward the other free edge creating a fold line and subsequently folding the fold line toward the transverse free edge creating another fold line and three panels; see figures 1 and 2a.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 82-83 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazar (US 1,256,334) in view of Applicant's Admitted Prior Art (AAPA).

Lazar does not directly disclose the ranges of dimensions, nor the weight per sq ft of the product. It would have been obvious to one of ordinary skill in the art to apply the folding method of Lazar to various sizes and weights of webs including those of claims 82 and 87. The method of folding does not seem to be affected by the claimed dimensions or the claimed weight ratio and providing such a dimensioned or weighted web solves no stated problem. The previously made common knowledge modification is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.

9. Claims 84-85 and 88-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 4,469,243).

Ito describes forming transverse folds in a web in order to produce wipes. The invention contemplates multiple fold configurations as well as materials; see column 7, lines 40+; figure 1.

Ito does not directly disclose the use of a single ply paper web (rather a four ply for added strength) however it would have been obvious to one of ordinary skill in the art to use the method for a single ply if desired; Applicant has not disclosed that a single ply paper web provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any web of foldable material because the method steps do not rely upon the material being folded.

Further note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

10. Applicant's arguments filed 8/14/06 have been fully considered but they are not persuasive. Again the rejection under 35 USC 112 is maintained. As discussed in the interview of 7/19/06, applicant is required to specify on the record what is to be encompassed by the term about. Stating "one example" (ie. machine tolerances) that "may cover" what is meant is ambiguous.

Because the ranges are not specific ie. the claimed ranges (also provided for in the specification) include the term "about", it is uncertain to what degree is encompassed. At least about two times a dimension, which variables are also "about" a value provide too much uncertainty of the scope of the claim. See also MPEP 2173.05(b) and *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200 (1991) where the court held that claims reciting "at least about" were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term "about." Specific guidance in the specification has not been found.

Note also regarding the "machine direction" and "cross-machine direction" (as discussed in the interview of 7/19/06) a paper napkin does not necessarily have these characteristics. For something to have an inherent characteristic the characteristic cannot be a probability (no matter how high) but rather a certainty. Applicant is

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encouraged to further define the "machine" and "cross machine" directions within the claim.

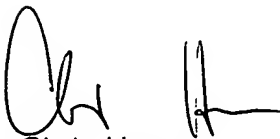
The folds in Lazar are considered in a singular direction; see figures 4-7.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Chris Harmon
Patent Examiner